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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/696,690

10/29/2003

Karl Lubitz

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31625

7590

07/09/2004

BAKER BOTTS L.L.P.  
PATENT DEPARTMENT  
98 SAN JACINTO BLVD., SUITE 1500  
AUSTIN, TX 78701-4039

EXAMINER

DOUGHERTY, THOMAS M


ART UNIT

PAPER NUMBER

2834

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicati n No.</b>	<b>Applicant(s)</b>	
	10/696,690	LUBITZ ET AL.	
	<b>Examin r</b>	<b>Art Unit</b>	
	Thomas M. Dougherty	2834	

-- The MAILING DATE of this communication appears n th c ver sheet with the corresp ndence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1003</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Under *In re Hammack*, 166 USPQ 204 (CCPA 1970) and *In re Moore*, 169 USPQ 236 (CCPA 1971), claims must be analyzed to determine their metes and bounds so that it is clear from the claim language what subject matter the claims encompass. This analysis must be performed in light of the applicable prior art and the disclosure. The definiteness of the claims is important to allow others who wish to enter the market place to ascertain the boundaries of protection that are provided by the claims. *Ex parte Kristensen*, 10 USPQ 2d 1701, 1703 (PTO Bd. Pat. App. & Intf. 1989). Use of a narrower range within a broader range in the same claim renders the claim indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. One could not tell from such a claim if the narrower range or limitation is a restriction or limitation on the broader range or limitation. Examples of specific claim language which have been held to be indefinite are:

1) "or the like" – *Ex parte Caldwell*, 1906 CD 58 (Commr Pats 1905) "coke, or brick or like material" held to be indefinite.

2) "such as ..." – *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948).

3) "for example, ..." – *Ex parte Lasche*, 86 USPQ 481 (Bd. App. 1949).

In view of the above, claims should be rejected as being vague and indefinite under 35 USC. 112, second paragraph, which recite a broad range or limitation followed by linking terms (e.g., preferably, maybe, such as, for example, for instance, **especially**) and a narrow range or limitation within the broad range or limitation. The use of these exemplified terms is not indefinite per se, but the use of these terms to link broad and narrow ranges or limitations renders the claim indefinite. The applicants thus employ "especially for a piezoelectric component" in claim 1, which renders the claims indefinite for the reasons cited above.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Heinz (WO 00/63980). Heinz shows (fig. 1) an additional contacting for an electrical component (1), especially for piezoelectric component (1) in the form of a multilayer structure, comprising more than one connecting element (6) for connecting the electrical component (1) with an electrical connection element (7), wherein the additional contacting (5) is embodied as a single, structured component.

The additional contacting (5) is embodied as a single, structured foil.

Each connecting element (6) is connected to a single, shared current conductor track (10).

The current conductor track (10) has a greater width compared to each connecting element (6).

The width of a current conductor track (10) changing over the length of the current conductor track (10).

The structured component comprises a contacting zone (edges of 2a) in which an electrical access element (2a) can be located.

The additional contacting (10) is surrounded in at least some areas by a passivation material, see 9 in figure 4 which is an elastomer.

Claims 1, 2 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto (US 6,104,129). Okamoto shows shows (figs. 3, 5A, 5B) an additional contacting for an electrical component (20), especially for piezoelectric component (20) in the form of a multilayer structure, comprising more than one connecting element (27c) for connecting the electrical component (20) with an electrical connection element (understood or else the device cannot do any useful work), wherein the additional contacting (27c) is embodied as a single, structured component.

The additional contacting (27) is embodied as a single, structured foil.

The structured component comprises a contacting zone (edges of 22a, 22b) in which an electrical access element (22a, 22b) can be located.

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The additional contacting (27) is formed in at least some areas from a material with higher electrical conductivity.

The additional contacting (27) is formed from at least one material from the group Cu, Cu alloy, Fe, steel, Ni basic alloy, Co basic alloy. See column 4, lines 29 to 35.

The additional contacting (27) is surrounded in at least some areas by a passivation material (23).


### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The remaining prior art cited reads on some aspects of the claimed invention.

Direct inquiry concerning this action to Examiner Dougherty at (571) 272-2022.

tmd  
tmd

June 15, 2004

  
**THOMAS M. DOUGHERTY**  
**PRIMARY EXAMINER**  
**GROUP 2109**